

### **REMARKS**

Claims 1-13, 79-82 and 94-108 are pending in this application. Claims 6-13, 79-82, and 106-108 have been allowed. Claims 5, 94, 95, 96, 101, 102, 103, and 105 have been objected to. Claims 1-4, 93, 97-100 and 104 have been rejected under 35 U.S.C. §102(b).

Claims 4, 5, 80, 93-97, 100-103 and 105 have been amended with no new matter having been added.

### **Rejections under 35 U.S.C. § 102(b)**

Claims 1-4, 93, 97-100 and 104 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,057,165 to Mansour (hereinafter “Mansour”). Applicants traverse this rejection.

### **Independent Claim 1**

A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described in a single prior art reference. MPEP §2131. Applicants believe that Mansour does not anticipate the present invention because it does not set forth at least one of the claim elements of independent claim 1. In particular, Mansour does not disclose, teach or suggest the claim limitation of “*seals the first opening to prevent fluid flow*”. The claim requires the carrier to close and to seal the first opening to prevent fluid flow. This limitation is not found in Mansour and therefore, Mansour does not anticipate independent claim 1.

In contrast, fluid flows out of the reservoir in Mansour through a system of porous and flow control layers. “The assay composite 40 is comprised of a porous membrane 41...” Mansour, col. 11, lines 7-8. The porosity of the composite is discussed in Mansour at col. 11, lines 5-17. “Adjacent to the lower surface of the porous membrane 41 is a flow control layer 42 which is preferably formed from a unidirectional flow-controlling polycarbonate membrane having a pore size of 0.6 micron.” Mansour, col. 11, lines 14-17. “Immediately underneath the flow control layer is a porous spacer layer 42 which generally has a pore size greater than the pore size of flow controlling layer”

42.” Mansour, col. 11, lines 18-20. “Immediately underneath the porous spacer layer 43 is absorptive layer 44.” Mansour, col. 11, lines 22-23.

Clearly, in Mansour the reservoir is not sealed and fluid is allowed to flow through the various porous and flow-control layers. Actually, there is nothing even beyond the absorptive layers to further contain fluid flow within the reservoir at that end. In fact, spaces are provided to ventilate the assay composite 40. See Mansour at col. 11, lines 46-50 (“The cover 46 is supported over porous membrane 41 by teeth-like projections 49 extending upward from the sides of the base 45. The projections 49 are of sufficient height to provide air spaces 50 which provide for ventilation of the sides of the assay composite 40.”). Mansour’s device peculiarly ventilates the assay composite which according to the Office is an equivalent to the sample. ***In such a construction, fluid flows into, through and past the sample and even capably beyond them and through the spaces 50 in Mansour.*** Therefore, Mansour is quite different from applicants’ invention as claimed and not anticipated for this reason.

To further emphasize this fluid flow from the reservoir at the end where the sample is located in Mansour, applicants refer the Office to col. 12, lines 2-7 of Mansour which reads as follows:

A test sample is applied to the test area 60 through delivery device 10 whereby the sample contacts the binder in test area 60, with the sample flowing through the assay composite to the absorbent layer 44. The analyte present in the sample will become specifically bound to the binder in area 60.

Also, at col. 12, lines 8-11, Mansour states:

Thereafter, tracer is applied to the test area 60 through the delivery device 10. The tracer becomes bound to the analyte, and any unbound portion flows through to the absorbent layer 44.

And, again at col. 12, lines 28-29, Mansour states:

...with sample flowing through to the absorbent layer 44.

In Mansour, sample flows out of the reservoir and through the composite of layers. The carrier does not seal the reservoir at that end where the sample is located.

Therefore, Mansour does not anticipate the present invention as claimed. For this reason, independent claim 1 and its dependent claims are in a condition for allowance.

#### **Independent claims 93 and 100**

Applicants have amended independent claims 93 and 100 to include the limitation of closing the first opening and preventing fluid flow across the first opening. Mansour does not disclose, teach or suggest closing the first opening to prevent fluid flow as discussed above with respect to independent claim 1. For the same reasons as recited above for independent claim 1, independent claims 93 and 100 and their respective dependent claims are not anticipated by Mansour and are in a condition for allowance.

#### **Dependent claims 4, 97 and 104 and reply to “Claim Observations”**

The Office states that:

Claim 4 recites “wherein some non-specifically transferred material is excluded from the reservoir”. The claim is unclear because non-specifically transferred material is not recited as a position limitation. It is suggested that Applicants amend claim 4 to recited “wherein non-specifically transferred material is present on the carrier and wherein some non-specifically transferred material is excluded from the reservoir.”

Office Action at pg. 2. Applicants would like to thank the Office and have amended claim 4 according to the Office’s suggestion.

Dependent claims 4, 97 and 104 were rejected by the Office as being anticipated by Mansour. Applicants traverse this rejection. A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described in a single prior art reference. MPEP §2131. Applicants believe that Mansour does not anticipate the present invention because it does disclose, teach or suggest the limitation of non-specifically transferred material being excluded from the reservoir. Firstly, Mansour does not have transferred material on what the Office identifies as the carrier. And furthermore, what the Office identifies as the carrier does not have transferred material that was non-specifically transferred to the carrier. For these reasons, Mansour does not

anticipate dependent claims 4, 97 and 104 and therefore, these claims are in a condition for allowance

#### **Dependent claim 99**

The Office rejected dependent claim 99 on the as being anticipated by Mansour. Applicants traverse this rejection because Mansour does not disclose a “centrifuge tube” or a “microtiter plate” as recited in claim 99. Because these elements are not found in Mansour, the claim is not anticipated by it. Therefore, claim 99 is also in a condition for allowance.

#### **Dependent claim 80**

Dependent claim 80 was amended to correct a spelling mistake.

#### **Extraction**

The Office states that:

“Mansour does not disclose the cover having the conduit as an extraction unit. However, in the claims the extraction unit is defined as having a carrier receiving portion and a conduit extending between a first opening and a second opening of the carrier-receiving portion.

Office Action, pg. 3, paragraph 2. The term “extraction” should be afforded the broadest interpretation as is possible.

#### **Allowable subject matter**

Applicants wish to thank the Office for allowing claims 6-13, 79-82 and 106-108.

With respect to objected claims, applicants have rewritten claims 5, 94, 95, 96, 101, 102, 103 and 105 in independent form incorporating all of the limitations of the base claim and any intervening claims.

The Office states that the “[t]ransfer film has been interpreted in light of the specification as a film adapted for absorbing energy delivered by a laser pulse or multiple laser pulses and further adapted for expanding and adhering to the target cells (specification page 10, paragraph 52).” Office Action, pg. 4, paragraph 4. Applicants

believe that the Office adopted an unnecessarily overly narrow interpretation of the term “transfer film.” While applicants agree that the term “transfer film” should be interpreted in light of the specification, the specification of the present invention at paragraph 63 states:

**The invention is not limited to transfer films comprising heat activated adhesive materials. Pressure sensitive adhesives may be employed as well as other materials and types of transfer films 28.**

Therefore, in light of the specification, the term “transfer film” requires a broader interpretation than that afforded by the Office. The term “transfer film” should be interpreted in light of the specification affording the broadest possible interpretation with it being understood that the invention is not limited to the particular forms disclosed and that the invention is to cover all modifications, equivalents, and alternatives falling within the spirit and scope of the invention.

#### **Finality of Office Action**

The Office has marked the status of the office action as being “FINAL”. Applicants believe that this is incorrect and the finality of the office action is believed to be inappropriate. The MPEP at §706.07(a) states that

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by the applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

*See also*, MPEP §609(III)(B)(2)(a)(i) & (ii).

The finality of the office action is inappropriate because the Office introduced a new ground of rejection that was not based on information submitted in an information disclosure statement. The Office uses Mansour in making its rejections in the present office action. Mansour was not cited by the Office or by the applicants in an information disclosure statement and a new ground of rejection is based on material that was not submitted in an information disclosure statement or previously cited by the Office. The

Office apparently conducted an additional search and uncovered Mansour and used it to reject claims. For these reasons, applicants respectfully request withdrawal of the finality of the office action.

In view of the foregoing remarks, applicants respectfully submit that the application is in a condition for allowance, and action toward that end is earnestly solicited. The Office is invited to contact the applicant's representative at the number below to facilitate prosecution of this application.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time.

Respectfully submitted,

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